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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/458,033 06/01/95 HINDLEY

R 0132-138H

EXAMINER

GERSTL, R

12M2/0930

ART UNIT

PAPER NUMBER

HOPGOOD CALIMAFDE KALIL
& JUDLOWE
60 EAST 42ND STREET
NEW YORK NY 10165

DATE MAILED: 09/30/96

09/30/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6-24-8-7-96
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above, claim(s) 14, 15 is/are withdrawn from consideration.
- ☒ Claim(s) 13 is/are allowed.
- ☒ Claim(s) 1-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1201

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5521201. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap.

The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14 and 15 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 8.

The following claim corresponding to claim 1 of U.S. Patent No. 5521201 is suggested to applicant under 35 U.S.C. § 135(a) for the purposes of an interference:

--A method of treating impaired glucose tolerance comprising administering to a host suffering therefrom a therapeutically

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effective amount of 5-(4-(2-N-methyl-N-(2-pyridyl)amino)ethoxy)benzyl)-2,4-thiazolidinedione.

The suggested claim must be copied exactly, although other claims may be proposed under 37 C.F.R. § 1.605(a).

APPLICANT MUST COPY THE PATENT CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. THE EXTENSION OF TIME PROVISIONS OF 37 C.F.R. § 1.136(a) DO NOT APPLY TO THIS TIME PERIOD. FAILURE TO COPY THE CLAIM WILL BE TAKEN AS A CONCESSION THAT THE SUBJECT MATTER OF THIS CLAIM IS THE PRIOR INVENTION OF ANOTHER UNDER 35 U.S.C. § 102(g) AND THUS ALSO PRIOR ART UNDER 35 U.S.C. § 103. *In re Oguie*, 186 USPQ 227 (CCPA 1975).

Applicant need not respond to the remaining issues in this action if a suggested claim is copied for the purpose of an interference within the time limit specified above, 37 C.F.R. § 1.605(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Gerstl whose telephone number is (703) 308-4531. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ROBERT GERSTL
PATENT EXAMINER
SEP 25 1996

GERSTL:jd
SEPTEMBER 25, 1996

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This application contains claims 1-12 are drawn to an invention non-elected with traverse in Paper No. 1. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14 and 15 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Gerstl whose telephone number is (703) 308-4531. The fax phone number for this Group is (703) 308-4556.

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Art Unit: 1201

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

GERSTL:jd
SEPTEMBER 20, 1996